REMARKS

Applicants appreciate the time taken by Examiner Felten to speak by telephone with Applicants' representative Steven Underwood on January 19, 2005. During that conversation, Mr. Underwood pointed out that Applicants' argument that the Castiglione reference does not appear to be prior art was not addressed in the instant Final Office Action. Examiner Felten stated that he would review that reference and Applicants' arguments related thereto and withdraw the finality of the instant Office Action if he could not establish that Castiglione is prior art. Applicants appreciate that assurance.

Claims 1-10 are now pending in this application. The following remarks are in response to the Final Office Action mailed October 20, 2004. However, all remarks made in the Response filed July 19, 2004 are incorporated herein by reference.

Preliminarily, Applicants respectfully note that it is improper to ignore (that is, fail to address) good-faith arguments made in response to office actions. See MPEP § 707(f): "Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." Applicants respectfully submit that the present Office Action fails to address many of the grounds for traversal made in the preceding response, and trust that the Action following the instant Response will separately address each of the grounds for traversal and other arguments made herein.

Also, Applicants respectfully submit that if a publication retrieved from the Internet or an on-line database does not include a publication date or retrieval date, it cannot be relied upon as prior art under 35 U.S.C. § 102(a) or (b). See MPEP § 2128; Electronic Publications as Prior Art; Date of Availability.

In the office action mailed September 26, 2003, the Patent Office stated that claims 6-10 would be allowable if re-written in independent form. Those claims were re-written in independent form in Applicants' response filed January 26, 2004. Since the present Office Action (like the previous office action, mailed April 20, 2004) does not treat claims 6-10 separately from claim 1, Applicants remain confused regarding the specific grounds on which (previously allowable) claims 6-10 have been rejected. Clarification is again respectfully requested.

Claims 1-10 now stand rejected under 35 U.S.C. § 103 as unpatentable over U.S. Pat. No. 6,012,042, to Black et al. in view of U.S. Pat. No. 5,444,819, to Negishi and further in view of Castiglione, F., "Forecasting price increments using an artificial Neural Network." This rejection is respectfully traversed.

The subject application has a priority date of April 7, 2000. The article by Castiglione, as far as Applicants have been able to determine, was published in March 2001 (see Internet printouts submitted with July 19, 2004 response). However, even if Catiglione was published in 2000, that doesn't necessarily make it prior art. To be prior art, it would need to be published before April 7, 2000.

If the Patent Office can demonstrate a publication date of the Castiglione article that is earlier than April 7, 2000, it is invited to do so. Otherwise, the claim rejections based on Castiglione should be withdrawn. Applicants reserve the right to substantively address the Castiglione reference (or to swear behind it) if the Patent Office provides evidence that Castiglione was published early enough to qualify as prior art.

Further, although Applicants appreciate the Patent Office's admission in the previous action that Black and Negishi, even if combined, do not render the pending claims unpatentable, the Office Action fails to provide sufficient justification for combining any of the three cited references. The Office Action states:

> [B]ecause Black includes within the invention's process the technical analysis of price data, it would have been obvious for an artisan of ordinary skill in the art at the time of the invention of Black[1] to integrate/substitute the pattern recognition processor as well as the curve fitting technique disclosed within Negishi and Castiglione, as alternatives to Black's price data analysis because an artisan at the time of the invention of Black would have been motivated to use these (and various other) well known techniques to effectively analyze market price data and find new market trends..

The assertions quoted above are problematic for at least a couple of reasons.

---

[1] Although a minor point, Applicants respectfully note that the test for obviousness relates to the time of Applicants' invention – not Black's invention. See, e.g., MPEP § 2141.01 (III).

First, there is no "pattern recognition processor and curve fitting technique" "disclosed within Negishi and Castiglione." Negishi discloses a "pattern sorting unit" and Castiglione (although it does not appear to be prior art) discloses a curve fitting technique – but neither Negishi nor Castiglione, separately, discloses a "pattern recognition processor and curve fitting technique." The Patent Office appears to be implicitly trying to combine Black with a *combination* of Negishi and Castiglione. And before alleging that one skilled in the art would be motivated to combine the teachings of Black with a combination of Negishi and Castiglione, the Patent Office at least must first establish a motivation to combine Negishi with Castiglione. No such motivation is established, or even asserted, in the Office Action.

Second, the asserted "motivations" for combining Black with the combination of Negishi and Castiglione are not supported in the references. None of the references suggest that Black would be improved by substituting the teachings of Negishi or the teachings of Castiglione (either separately or in combination) for Black's "price data analysis." Indeed, it is not clear that combining Black with a combination of Negishi and Castiglione would even result in an *operable* system or method, much less an *optimal* system or method. A proposed combination "cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose." See MPEP § 2143.01.

The Office Action language quoted above is not sufficient to establish a *prima facie* case of obviousness. The alleged suggestion or motivation to combine Black with a combination of Negishi and Castiglione must be based on objective evidence in the record. See MPEP 2143.01 and *In re Lee*, cited therein (copy submitted with July 19, 2004 response)). Moreover, as discussed above, to support its rejections the Patent Office must separately establish a motivation to combine Negishi with Castiglione – and the Office Action does not do that.

The only response in the instant Office Action to the above arguments is that "the test for combining references is the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art." This statement ignores the other criteria for establishing a *prima facie* case of obviousness (see MPEP § 2143), nor does it explain how taking the cited references as a whole provides a motivation to combine Negishi with Castiglione, or Black with the combination of Negishi and Castiglione.

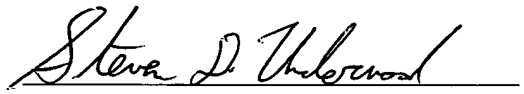
There are other problems with the Office Action and its predecessor (for example, the characterizations of Negishi and Castiglione, and what a "combination" of those references would result in), but for the sake of efficiency Applicants forgo discussing those problems until the Patent Office provides evidence showing that Castiglione is prior art.

All claim rejections are believed to have been overcome by this Response. All pending claims are therefore believed to be allowable, and a prompt Notice of Allowance would be appreciated.

No fee is believed to be due with this Response.. Please charge any fee insufficiencies to Deposit Account No. 50-0310.

Respectfully submitted,

Dated: January 20, 2005



Steven D. Underwood, Esq.
Registration No. 47,205
MORGAN, LEWIS & BOCKIUS LLP
Customer No. 09629
(212) 309-6000